

REMARKS

Claims 19 are pending. By this Amendment, the specification is amended and claims 1, 11, and 15 are amended. No claims are canceled or added.

The specification and figures 1 and 2 are amended to replace element number 140 with 110 when referring to the support area. Element number 140 is used to designate a cinch strap in Figure 17 and in the paragraph beginning on page 7 at line 3. Hence, the foregoing amendment eliminates duplicate element numbering inadvertently present in the instant Application. None of the foregoing amendments to the specification and figures introduce new matter into the instant Application.

Claim 1 is amended to recite that the first and second pluralities of swing arms "having first and second ends,; that the first and second pluralities of swing arms are rotatable "proximate the first ends," and that the first and second pluralities of swing arms "are engageable with other at the second ends." Support can be found, e.g., in the paragraph beginning at page 6, line 9 and Figures 1 and 4.

With the same support as recited with respect to claim 1, claim 11 is amended to recite "providing a riser cart," rather than "forming a riser cart, "first and second swing arms" in place of "a first swing arm," that the first and second swing arms are pivotally mounted at first ends thereof," and are "engageable at a second end thereof."

Claim 15 is amended to no longer recite the second swing arm now recited in claim 11. For the reasons stated below, reconsideration and withdrawal of the rejections are respectfully requested.

35 U.S.C. § 103

1. Claims 1-5, 7-8, 10-13, and 15-18 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. 548,273 ("Rouse"), in view of U.S. 4,895,381 ("Farlow"). Applicant respectfully traverses this rejection. However, in order to advance the prosecution of this application, claims 1 and 11 are amended as described above. While the arms B of Rouse lock on the vertical sides A, they engage other at a first end where they are pivotally mounted, but not at a second end A.¹ Because the foregoing limitations is neither disclosed nor suggested by either Rouse or Farlow, claims 1 and 11 are not obvious in view of these documents.

Applicant's traversal is further based on the fact that the requisite motivation to modify the disclosure of Rouse with the disclosure of Farlow has not been shown. In order to establish a prima facie case of obviousness, a rejection must, inter alia, establish the required motivation for modifying the documents cited against the claims. The motivation to modify the documents cited against the claims must be present in the documents themselves or otherwise in the prior art, not in the instant application^{2,3} and must be "clear and particular."⁴ Moreover, neither

¹ Rouse, beginning at column 2, line 54 ("Each sleeve is provided on one end with projections c and on the other end with notches d, the notches on each sleeve being adapted to be engaged by the projections on the next sleeve when said sleeves are placed one upon another on the frame, as shown."); Figures 3 and 4.

² See M.P.E.P. § 2142 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.").

³ Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985) ("Regarding an invention directed to a combination of known elements, the Board indicated that the examiner had done little more than cite references showing that elements or subcombinations of them were known. To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.").

conclusory statements within the rejection nor subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.⁵ Similarly, if the rejection asserts that the motivation was generally present in the art at the time of the invention, the rejection then asserts facts alleged to be known to the Examiner. These facts known to the Examiner must themselves be stated for the record. Thus, the Examiner may be required to execute an affidavit or declaration to that effect so that the Applicant may have the opportunity to explain or dispute the assertions therein.⁶

The rejection states that "Rouse teaches a rack support frame[,] a first swing arm post (A, B left) assembly ...[and a] second swing arm post assembly mounted to the cart support frame."

⁴ See In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[The] district court's conclusion of obviousness was error when it 'did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination.' [citations omitted] ... The range of sources available, however, does not diminish the requirement for actual evidence. That is the showing must be clear and particular.") (emphasis added).

⁵ See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed Cir. 2002) ("The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.") (internal quotation marks omitted) (emphasis added).

⁶ See M.P.E.P. § 2144.03 ("As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 59 USPQ2d 1693, 1697.... If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2)['When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons'].") (emphasis added).

After admitting that "Rouse does not teach a cart with wheels attached," the rejection then states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a wheeled frame for supporting the rack taught by Rouse, in order to easily transport the same items supported by the rack and position the rack in a convenient location for the users." As shown above, the required motivation to modify the disclosure of Rouse with the disclosure of Farlow must be found in the prior art, not the disclosure of the instant Application. However, the rejection fails to cite any portion of Rouse, Farlow or other prior art document "clear and particular" motivation can be found. Indeed and as shown above, the rationale for the rejection is simply unsupported opinion, which is not adequate to provide the requisite motivation. Because unsupported opinion cannot support the required motivation to modify the disclosure of Rouse with the disclosure of Farlow, a prima facie case of obviousness has not been established. Stated otherwise, the mere presence of a claim limitation per se, e.g., in the form of a structural feature, does not itself provide the required motivation for using that feature to modify the disclosure of another document. If the rejection is maintained, the Examiner is respectfully required to cite supporting portions of Rouse, Farlow, or another prior art document. Alternatively, the Examiner is required to execute an affidavit or declaration asserting with particularity facts supporting the requisite motivation and to which Applicant can subsequently explain or traverse.

Because the required motivation to modify the disclosure of Rouse with the disclosure of Farlow has not been shown, a prima facie case of obviousness has not been established with respect to claims 1 and 10. The other rejected claims depend directly or indirectly from claim 1 or claim 10. Therefore, a prima facie case of obviousness has not been shown for the other

rejected claims as well and reconsideration and withdrawal of the rejection are respectfully requested.

2. Claims 9 and 19 are rejected under 35 U.S.C. § 103(a) as obvious over Rouse in view of Farlow as applied to claim 1 above and further in view of U.S. 2,514,308 ("Burg"). Applicant respectfully traverses this rejection. However, in order to advance the prosecution of this application claims 1 and 11 are amended as described above. Applicants note that Burg fails to disclose or suggest the limitations amended into claims 1 and 11. Claims 9 and 19 depend from respective claims 1 and 11. Because neither Rouse nor Farlow discloses or suggests these limitations, claims 9 and 19 are not obvious over the combination of Rouse, Farlow and Burg. For reasons stated above, Applicant respectfully submits that the motivation to modify the disclosure of Rouse with the disclosure of Farlow has not been shown. Additionally, Applicant respectfully submits that the requisite motivation to modify the disclosures of Rouse and Farlow with the disclosure of Burg has not been established as well.

Rather than cite portions of Rouse, Farlow or Burg which might support the proposed modification, the rejection opines that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cart rack assembly taught by Rouse modified by Burg to include back rail support posts for providing means on the cart [for] carrying additional items of significant horizontal length for providing additional means of storing items and saving on storage space." As shown above the foregoing unsupported conclusory opinion - in the absence of objective evidence - is not sufficient to show the requisite motivation. If the rejection is maintained, the Examiner is respectfully required to provide

portions of Rouse, Farlow, Burg, or another prior art document which support the required motivation. Alternatively, the Examiner is required to execute an affidavit or declaration asserting with particularity facts supporting the requisite motivation and to which Applicant may subsequently explain or traverse.

Because the required motivation to modify the disclosures of Rouse and Farlow with the disclosure of Burg has not been shown, a prima facie case of obviousness has not been established with respect to claims 9 and 19 and reconsideration and withdrawal of the rejection are respectfully requested.

Allowable/Allowed Claims


3. The Office Action stated that claims 6 and 14 are allowable if rewritten in independent form including all the limitations of the base claims and any intervening claims. For reasons stated above, all pending claims are submitted to be in condition for allowance.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


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AMENDMENTS TO THE DRAWINGS

Figures 1 and 2 are amended to replace element number 140 with 110.

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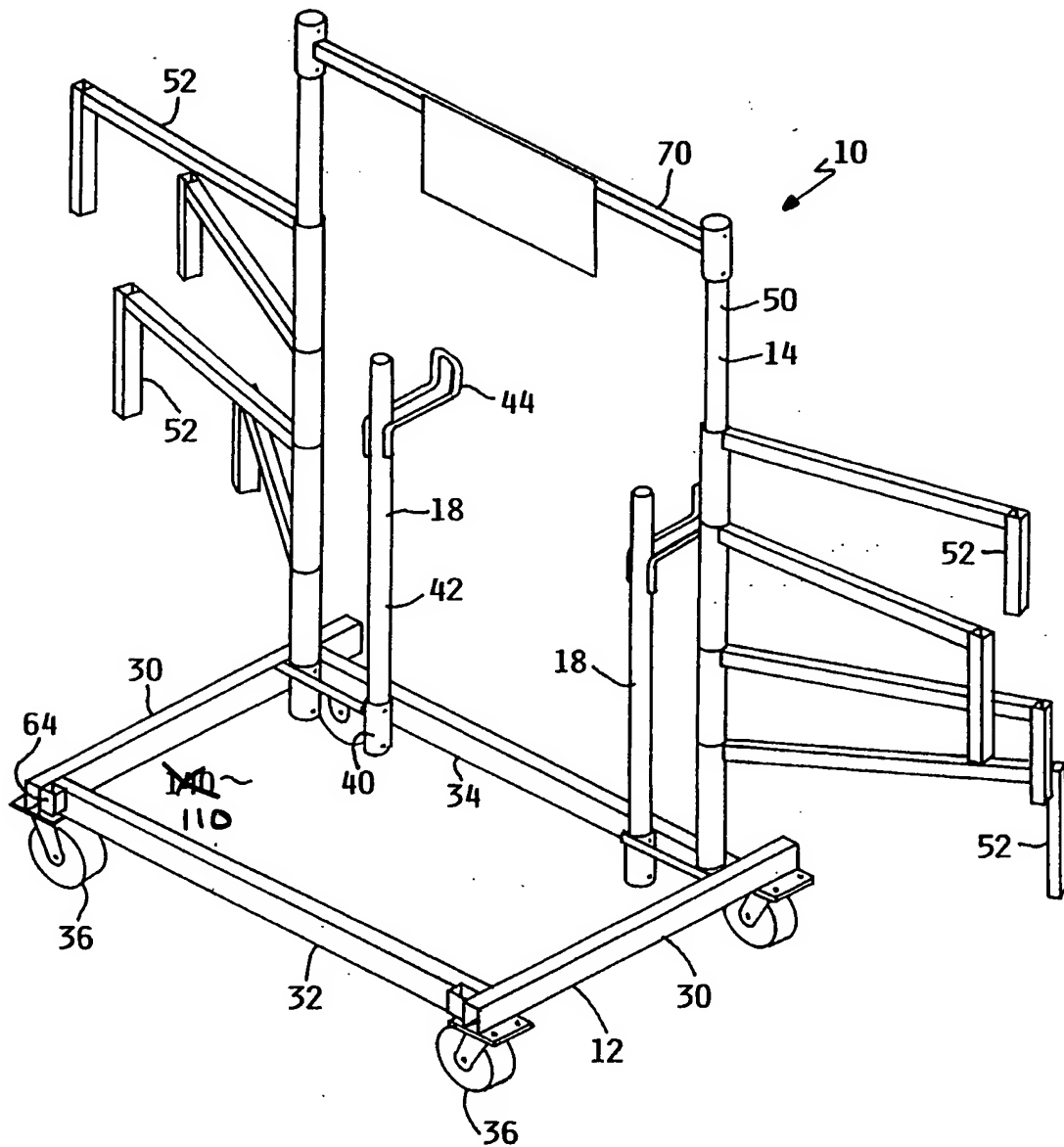


FIG. 1

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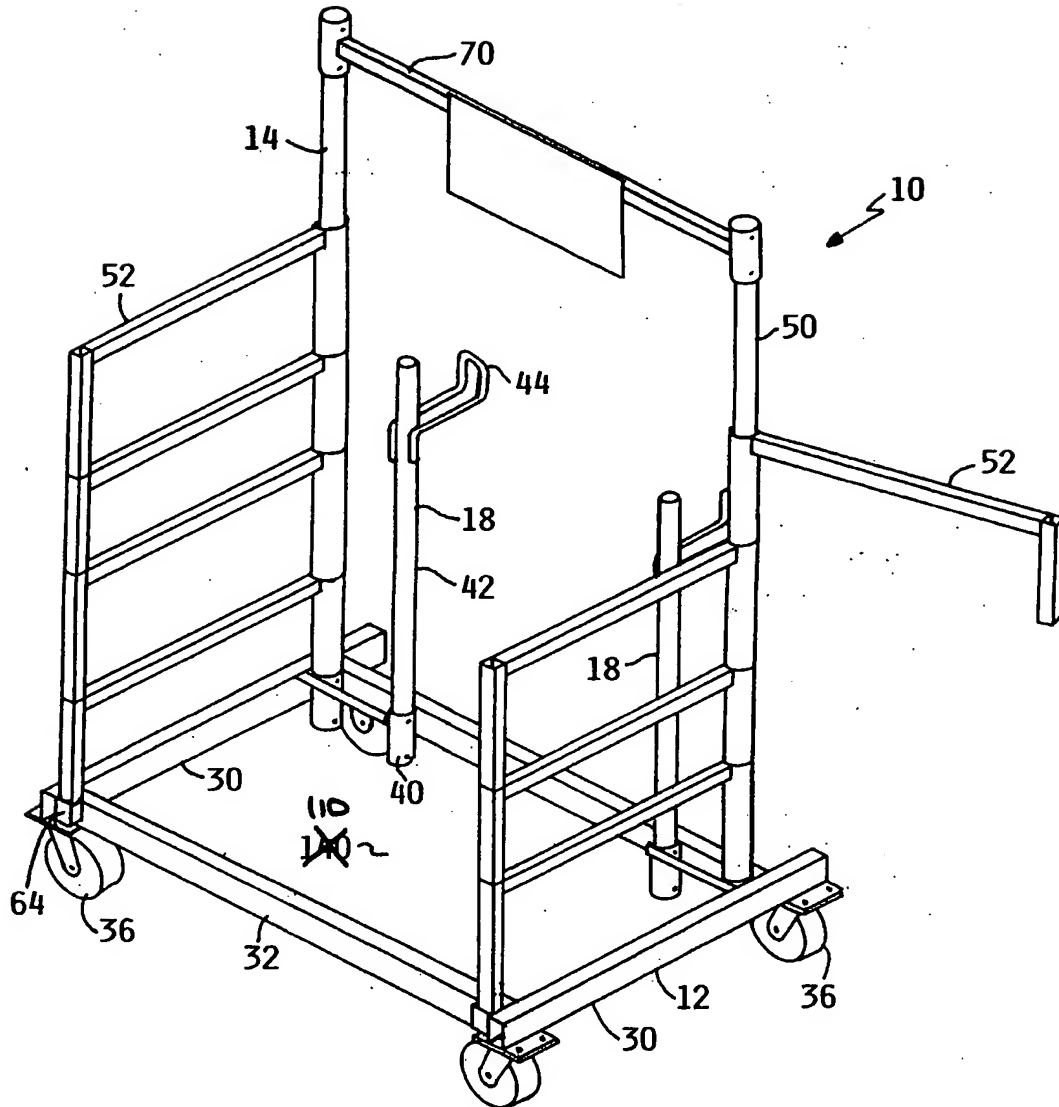


FIG. 2